

I. Rejection under §112

The Office Action rejects claim 12 under 35 U.S.C. §112, second paragraph. The Office Action alleges that the term "cis or trans forms of 1,3 cyclohexanediol and 1,4 cyclohexanediol" and the term "racemic mixtures thereof" are confusing. Applicants respectfully traverse the rejection.

Applicants do not necessarily affirm that claim 12 is indefinite. However, in the interest of advancing prosecution, Applicants amend claim 12 for additional clarity. Amended claim 12 defines the at least one cyclohexanediol compound selected from a Markush group. Claim 12 satisfies the requirements of 35 U.S.C. §112, second paragraph.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

II. Rejection under §102

The Office Action rejects claims 11-15 under 35 U.S.C. §102(b) over PCT publication WO99/18169. Applicants respectfully traverse the rejection.

The WO99/18169 reference published on April 15, 1999. Because the 1-year grace period defining a reference under §102(b) expired on Saturday, April, 15, 2000, this period extends to the next working day, i.e., Monday, April 17, 2000. The instant application claims the benefit of Provisional Application No. 60/197,669, filed on April 17, 2000. Therefore, the filing date of the instant application falls within the extended grace period. As such, the Office Action incorrectly identifies WO99/18169 as a §102(b) reference.

In addition, it appears that WO99/18169 cannot serve as a reference under §102(a), in view of the attached Declaration Under 37 C.F.R. §1.131. The attached Declaration establishes that Applicants conceived of the claimed invention and actually reduced it to practice prior to April 15, 1999. Therefore, because WO99/18169 is no longer a proper reference under 35 U.S.C. §102(a), the rejection must be withdrawn.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

III. Rejection under §103

The Office Action rejects claims 11-19 under 35 U.S.C. §103(a) over WO99/18169 in view of U.S. Patent No. 6,395,467 to Fahy et al. ("Fahy"). Applicants respectfully traverse the rejection.

In view of the fact that the primary reference is not prior art, this rejection must be withdrawn. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,



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Date: January 21, 2003

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APPENDIX

Changes to Claims:

The following is a marked-up version of the amended claim(s):

12. (Amended) A cryopreservation composition according to claim 11, wherein the at least one cyclohexanediol compound is selected from the group consisting of the cis form of 1,3-cyclohexanediol, ~~or the~~ trans forms of 1,3-cyclohexanediol, the cis form of 1,4-cyclohexanediol, and the trans form of 1,4-cyclohexanediol, and racemic mixtures thereof.